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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

THOMAS, ASHISH

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,952

Applicant(s)

TAKAYAMA, NORIHISA

Examiner

Ashish K. Thomas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/24/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-5, 7-8, 10-15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2002/0188683 by Lytle et al in view of U.S. Publication Number 2001/0034849 by Powers.

Regarding claims 1, 10, and 11, Lytle et al discloses, in Paragraph 158, Line 7-Paragraph 159, Line 2 and in Table 1, that the user inputs both the sending address as well as the receiving addresses. Meanwhile, Lytle et al discusses in Paragraph 168, Lines 3-12 that emails are sent to recipients whose email addresses are stored. Storing these recipient email addresses, in essence, is equivalent to the list creation means for creating a receiving address list mentioned in the current application. Lytle et al, however, does not consist of an address adding means which adds the inputted sender address to the receiving address list. Powers though discloses in Paragraph 118 a security means in which an email is sent to the sending address. Sending an email to the inputted sending address implies that this address is added to the receiving address list. Therefore, it would have been obvious for one with ordinary skills in the art, at the time of the present invention, to modify Lytle et al with Powers to

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formulate an address adding means for, when a sending address is input via the sending address input means, adding the sending address to the receiving address list.

Regarding claims 2 and 12, they adhere to all the limitations expressed in claims 1 and 11 as taught by Lytle et al and Powers. Note that Lytle et al states in Paragraph 168, Lines 3-12 emails are sent to a number of recipients whose receiving addresses are stored. This action represents the concept of "sending means for sending email based on the receiving address list" stated in the current application.

Regarding claims 3 and 13, Lytle et al teaches that emails are transmitted to the addresses contained in the receiving address list (Paragraph 168, Lines 3-12). While Lytle et al does not disclose that a sending address is added to the receiving address list, Powers does imply this. (Powers Paragraph 118). The combination of Lytle et al and Powers produces an email transmission apparatus that sends emails to both the inputted sender address along with inputted receiving addresses. Therefore, it would have been obvious for one skilled in the art, at the time of the present invention, to modify Lytle et al with Powers to form an email apparatus wherein the sending means sends the email to the sending address in the receiving address list in parallel with sending of the email to the receiving address in the receiving address list.

Regarding claims 4, 5, 14, and 15, they adhere to the limitations found in claims 2 and 12 according to the combined teachings of Lytle et al and Powers. As previously mentioned, Powers illustrates in Paragraph 118 a security

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checking means where an email is send to the user inputted sending address as well. Note that Powers depicts a method of “approving the proof copy” in Paragraph 118, Lines 9-10. The “proof copy” mentioned is the email sent to the sending address. Once email is approved, the sender’s legitimate identity is established. Once the legitimate identify of sender is established emails can be safely transmitted to the inputted receiving addresses. This reference inherently teaches that sending means sends the email to the sending address in the receiving address list independently of sending of the email to receiving address in the address list. It is also inherent that sending means sends the email to the sending address in the receiving address, and then only after a return communication is received thereto, sends the email to the receiving address in the receiving address list.

Regarding claims 7 and 17, Lytle et al discloses in Paragraph 168, Lines 3-12 that a receiving address list is created for all the receiving address inputted by the user. Furthermore, Lytle et al states in Paragraph 108, Lines 12-19 a method that checks to see if each recipient has an unique address. However, Lytle et al does not teach a step for adding the sending address to the receiving address list nor does it mention a step that checks to see if the sending address is unique. Powers, on the other hand, discloses in Paragraph 118 that a sending address could be added to the receiving address list. A person knowledgeable in the art could utilize the principle behind identifying a unique recipient address to devise a method that identifies a unique sender address that is not registered. Therefore, it would have been obvious for one with ordinary skill in the art, at the

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time of the present invention, to modify Lytle et al with Powers to devise an email transmission apparatus comprising registration means for registering a unique email address assigned to the email transmission apparatus, and wherein the address adding means adds the sending address to the receiving address list when the sending address input via the sending address input means does not match the unique email address registered by the registration means.

Regarding claims 8 and 18, it adheres to all the limitations found in claims 1 and 11 according to the combined teachings of Lytle et al and Powers. In fact, Powers states in Paragraph 118, Lines 6-8 that a "security mechanism" is used verify the identity of sender, the mechanism constituting of sending a copy of the email to the inputted sender address. The term "security mechanism" emphasizes the safeguarding involved in this process. In that, it would be difficult for the sender to delete the inputted sending email address from the recipient list. As a result, the address adding means adds the sending address to the receiving address list in a format such that it cannot be deleted from the receiving address list.

2. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2002/0188683 by Lytle et al in view of U.S. Publication Number 2001/0034849 by Powers and further in view of U.S. Publication Number 2002/0013817 by Collins et al.

Regarding claims 6 and 16, the combination of Lytle et al and Powers illustrates an email transmission apparatus in which a sending address is incorporated into the receiving address list. However, the combination of Lytle et

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al and Powers does not state that the sending address only receives a portion of the email. Collins et al however discusses in Paragraph 40, Lines 8-12 the capability of transmitting emails with both attachments and textual data to some recipients while only transmitting textual portions to other recipients. Similarly, one possessing pertinent skill in the art can formulate an email transmission device that sends only a certain portion of the email to the sending address. Once the sending address is verified, all parts of the email could be transmitted to all the recipients in the receiving address list. Therefore, it would have been obvious for one skilled in the art at the time of the present invention to modify the combination of Lytle et al and Powers with Collins et al to create an email apparatus wherein the sending means sends only a portion of data comprising the email to the sending address in the receiving address list.

3. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2002/0188683 by Lytle et al in view of U.S. Publication Number 2001/0034849 by Powers and further in view of U.S. Publication Number 2002/0112010 by Soroker et al.

Regarding claims 9 and 19, the combination of Lytle et al and Powers puts forth an email transmission apparatus that adds the sending address to the receiving address list. However, this combination does not involve a method that displays the addresses contained in the recipient list. Soroker et al, in paragraph 38, Lines 1-5, displays a list of all recipients. Therefore, it would have been obvious for one skilled in the art, at the time of the present invention, to incorporate Soroker et al with the combination of Lytle et al and Powers to

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generate a means for displaying the receiving address and sending address contained in the receiving address list.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashish K. Thomas whose telephone number is 571-272-0631. The examiner can normally be reached on Monday through Friday, 7am to 3:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MARK WALLERSON
PRIMARY EXAMINER